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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 Ex parte DANIELA GIACCHETTI
11

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13 Appeal 2008-2866
14 Application 10/024,482
15 Technology Center 3600
16

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19 Oral Hearing Held: February 10, 2009
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23 Before HUBERT C. LORIN, LINDA E. HORNER, and ANTON W.
24 FETTING, Administrative Patent Judges

25
26 ON BEHALF OF THE APPELLANT:
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36 The above-entitled matter came on for hearing on Tuesday, February 10,
37 2009, at the U.S. Patent and Trademark Office, 600 Dulany Street,
38 Alexandria, Virginia, before Victor Lindsay, Freestate Reporting, Inc.

P R O C E E D I N G S

MS. BOBO-ALLEN: Calendar No. 24, Appeal No. 2008-2866. Mr. Thissell.

JUDGE LORIN: Thank you very much.

MS. BOBO-ALLEN: Um-hum.

JUDGE LORIN: Good afternoon, counsel.

MR. THISSELL: Good afternoon, Judge.

JUDGE LORIN: Could you state your name, and spell your name for the record, please?

MR. THISSELL: Yes, my name is Jeremy Thissell. Last name is spelled T-h-i-s-s-e-l-l.

JUDGE LORIN: All right, thank you, counsel. We're familiar with the record. When you're, when you're ready, you may proceed. You have 20 minutes.

MR. THISSELL: Thank you. Actually have a couple of small sheets I'd like to hand out. They're nothing more than the figures from our own application and from the Orpaz patent but they're --

JUDGE LORIN: No, that's not necessary. We have copies of all the figures for us here.

MR. THISSELL: Okay. In that case, I thank you for the opportunity to come speak before you today. Again my name is Jeremy Thissell. I represent Mrs. Giacchetti, and as general background of this invention, the client has -- the applicant has sought to create a virtual make-up counter, if you will, where a user can, in the comfort of their own home on their own time, piece together a look or an appearance of beauty products in order to

1 let that user avoid the, the hassle and the time constraints of having to do
2 that in a department store. They can also do it a lot more quickly that way.
3 It's as simple as clicking one, two, three, and they can change the look of the
4 lipstick or eye shadow or whatever other beauty product they might be
5 applying.

6 And so I think the best example of that or the best illustration of that
7 is in appellant's own figure 10C, and that shows the claimed templates and
8 the, the simulation, the display that ultimately gets transformed by selecting
9 on these different templates, the templates being to the bottom right various
10 different configurations of eye shadow, blush, lipstick just as examples.

11 JUDGE FETTING: Which figure again?

12 MR. THISSELL: 10C.

13 JUDGE FETTING: 10C, thank you.

14 MR. THISSELL: Um-hum. And the first issue that we'd like to
15 address is the 101 rejection which I think first it's, it's worth noting that
16 claims 16 and 17 were not rejected under 101, and also it's worth noting that
17 this case fully completed briefing before the decision in re Bilsky .
18 However, I do think that our reply brief does cover the machine
19 transformation test that was clarified in Bilsky, among other tests that were
20 used in the past, but it does cover the machine transformation test.

21 JUDGE FETTING: So just for clarification.

22 MR. THISSELL: Sure.

23 JUDGE FETTING: So all, all of the claims that are rejected under
24 101 are method claims, correct?

25 MR. THISSELL: Yes.

1 JUDGE FETTING: And 16 and 17 are a system claim and a software
2 on a disk claim?

3 MR. THISSELL: That's correct.

4 JUDGE FETTING: Okay.

5 MR. THISSELL: So in terms of transformation, this application we
6 believe meets both the transformation and the machine prongs of the test.
7 As far as transformation goes, these templates, these images, the simulations
8 that occur is -- it's a transformation of this final display based on a selection
9 of the templates. The templates are -- they're representations of physical
10 objects, representations of facial portions, facial features, and when those are
11 selected, the central or main display is, is transformed and changed to look
12 any one of a number of different ways.

13 In terms of the machine prong of the test, again this is a representation
14 or simulation of a physical object, of someone's face. Furthermore, the
15 claims require that the simulation is displayed on a display device, so there
16 is an actual mechanical device that's involved in the claims.

17 JUDGE FETTING: Question.

18 MR. THISSELL: Sure.

19 JUDGE FETTING: It seems as though the Examiner relied heavily
20 on, on claim construction in coming up with the 101 rejection.

21 MR. THISSELL: Um-hum.

22 JUDGE FETTING: In determining that essentially none of the steps
23 actually require the use of a computer, nor do they actually require anything
24 that's actually in these claims be done because you do -- in the first step you
25 don't display, you facilitate display. In the second step, you don't select, you
26 enable selection, and in the third step again, you do not display, you

1 facilitate display. And you have defined your terms in your specification
2 such that I believe that -- this is on page 12 to 13, applying and selecting as
3 used throughout this application are to be interpreted as including direct and
4 indirect actions such as providing access to software, providing access to a
5 network site, cooperating with a third party who aids a user, and facilitating
6 as defined on page 27 again could involve either direct or indirect activity,
7 as an example, may include providing access to software for constructing
8 this.

9 So it seems as though the Examiner was construing the claim as
10 saying all three steps require nothing more than someone essentially
11 directing someone to where the software might be found, and your
12 specification would seem to corroborate such a construction.

13 MR. THISSELL: Well, the claims still require that the, the displaying
14 and the selection process be carried out so --

15 JUDGE FETTING: They do?

16 MR. THISSELL: Well, there's facilitation of this, this exercise, so --

17 JUDGE FETTING: It only requires facilitating it. It doesn't require
18 actually doing it. I can facilitate someone going up stairs by helping them
19 get to the bottom of the stair. After that, after I'm done facilitating them,
20 they can climb the stair, but that's a whole separate process.

21 MR. THISSELL: Well, if the, if the person never climbs the stairs,
22 then you haven't facilitated it.

23 JUDGE FETTING: I have facilitated it. They, they have chosen not
24 to do so.

25 MR. THISSELL: That's, that's our interpretation of the claims, is that
26 the, the process occurs and that the facilitation or the, the enabling is, for

1 example, on page 13, lines 1 to 4 of the specification, enabling includes
2 participating in any way in activities that aid the user.

3 JUDGE FETTING: Right.

4 MR. THISSELL: So the user is --

5 JUDGE FETTING: That's very broad.

6 MR. THISSELL: The user is making the selections, and the display is
7 being changed, and the, the claim requires the aiding of, of that process
8 being carried out. And so all of these -- and what we would like to point out
9 is that all of these definitions that we've, we've included in the specification
10 for facilitating and enabling, they all include some sort of activity one way
11 or the other. So whether it's direct activity of actually causing the display to,
12 to occur and change or to indirectly cause that to occur by providing access
13 to the program. So one way or the other, there is some sort of activity being
14 done by, by the, the facilitator or the enabler and, and that's, that is our
15 position on the 101 issue.

16 JUDGE LORIN: Well, let me see if I get this straight. What you're
17 saying is that these facilitating, enabling, facilitating display steps require
18 something to accomplish that result.

19 MR. THISSELL: Correct, and that the result -- we're, we're talking
20 about the result actually, you know, actually occurring. I mean if I just had a
21 claim that said enabling, facilitating and enabling with nothing more, then
22 that would be pretty broad, and it would include just about any type of
23 activity that the, the actor could do. But here there is detail after the
24 facilitating and enabling language that specifies what it is that goes on, and
25 the, the claim by virtue of this enabling and facilitating language indicates

1 that what's being performed is the, the actual performance or assistance in
2 some way of the steps that are taking place.

3 JUDGE FETTING: So the, so the steps have to occur but the -- that
4 still leaves the question of do they actually have to occur within what is
5 being described in the claim language or is it simply -- is enabling selection
6 followed by selection, selecting not being in the claim? I think that's the
7 issue.

8 MR. THISSELL: Could you rephrase that or restate it?

9 JUDGE FETTING: It, it is enabling -- and in fact, I think you just
10 said it, enabling selection is followed by the actual selection. But the claim
11 only calls for enabling selection. It may be followed by selection, but it's not
12 clear that the actual selection itself is in the claim. That may be another step
13 that's simply omitted from this -- the claim. That would occur but it's not in
14 the claim. I think that's the way the Examiner is interpreting -- is construing
15 the claim.

16 MR. THISSELL: I think I understand. Yeah, I think it's a difference
17 in how the Examiner is looking at it. Our position is that this is an overall
18 process that's occurring and that the enabling and facilitating are parts of that
19 process.

20 JUDGE LORIN: Yeah, you would like us to construe this claim to
21 say, for instance, that someone or something enables this result. But the
22 Examiner is viewing this as saying all you need to do is allow it to
23 potentially happen.

24 MR. THISSELL: Well, but it's more than just allowing something to
25 occur. It's -- if you're providing access to someone, access to this, this
26 program, access to the software, for example, the software has to be capable

1 of doing all these things, and you have to be assisting someone in some way
2 to use it. So for example, if you're a store owner and a salon owner, and you
3 have a computer station that's set up with this program on it, and you allow
4 your patrons to come in and use the program, you are enabling them to
5 complete this process. You're facilitating that process taking place.

6 So in that sense, that -- the claim has a broad scope as we discussed
7 before. You know, in one sense it can cover enabling and facilitating can
8 include direct action, actually displaying the simulation, but it also includes
9 the indirect action which would be what I described for example, a store,
10 salon owner who is providing access to the program for patrons who come
11 in.

12 JUDGE LORIN: Well, that's the difficulty here is the breadth of this
13 claim. I mean even your discussion about software computers, that's also
14 not in the claim. This claims simply calls for enabling display. It doesn't
15 say what type of display. Doesn't say how to display it. It just says enabling
16 display.

17 MR. THISSELL: But that, that sounds more like an issue for 112
18 more so than 101. The breadth of the claim doesn't limit its patentability in
19 terms of patent eligibility. We're --

20 JUDGE LORIN: Okay, so what do you say to that? What do you say
21 to that point?

22 MR. THISSELL: To what, to 112 where there --

23 JUDGE LORIN: The breadth of this claim?

24 MR. THISSELL: Well, and in fact, actually the breadth of the claim
25 doesn't speak to 112, second paragraph. The breadth of the claim is not to

1 be equated with indefiniteness. So really if we're talking about breadth, now
2 we're talking about art rejections, the novelty and the obviousness.

3 JUDGE LORIN: So you're saying this -- no matter how you look at
4 this scope, this, this claim covers patentable subject matter, because it
5 transform subject matter, and it operates on a machine?

6 MR. THISSELL: That, that is, that is part of our argument. I mean
7 you're talking about the breadth of the claim. The, the -- *Bilsky* held that --
8 upheld the notion that it didn't want to preclude or preempt anyone from
9 using some sort of fundamental process or excluding anyone else from using
10 the, the fundamental process, and these claims don't do that. These claims
11 don't take a fundamental process like converting binary numbers to analog
12 numbers and, you know, have the potential to create an exclusive right for
13 that, that applicant to be the only one who's allowed to use the, the
14 fundamental principle. In fact, here we're talking about a simulation,
15 changing an image, and we would argue that's not a fundamental principle at
16 all. So to the extent that the, the claim -- there's a concern that the claims are
17 not patent eligible under *Bilsky*, we don't believe that's the case.

18 JUDGE HORNER: On the transformation portion of the test in
19 *Bilsky*, it sounded like I heard you say that because you're taking the
20 selected template and then changing the simulated facial image that you've
21 got a transformation of data. In *Bilsky*, they talk about the holding in *In Re*
22 *Abele* where they're dealing with a CT scan of an actual human, that they
23 then take that raw data and convert it into a display, and there there's a true
24 transformation from the raw CT scan image into the display image. Here
25 we're just taking a simulation and, and calculating a new simulation. To me
26 that's a distinction between the transformation of the raw data like in *Abele*

1 and here they're taking -- you're taking a simulation and just making a new
2 simulation. How is that a transformation of the data?

3 MR. THISSELL: Well, it's, it's a transformation if, if you were to
4 look at the, the final product, the central image, element 700 in figure 10C, it
5 would be represented or it would be shown based on a series of, of data, a
6 collection of data, and upon selecting a different template with a different
7 beauty product applied, it will then change the composition of that data. It
8 will transform that data into something else and furthermore transform the
9 simulation, the actual image, into something else.

10 JUDGE HORNER: So under Bilsky, if somebody claims performing
11 a calculation and displaying it, that's all you need for transformation of data?
12 Doesn't matter what the data pertains to or how the data was, was initially
13 captured or anything?

14 MR. THISSELL: Well, the, the concern -- I mentioned the, the
15 conversion between, for example, a binary code and, and analog. That's a
16 transformation of data technically, but it's a fundamental principle of, of data
17 processing, and so we're not talking about taking ones and zeros and
18 changing it to something else. We're talking about changing it, a
19 composition, a simulation that has use for a user and, and changing it into
20 something else to help them to do something. And you know, in the same
21 way that Abele was talking about the CT scans or the X-rays, those were
22 representations of, of physical objects, of body parts, and this is the same
23 type of thing. It's a physical representation of a body part.

24 JUDGE HORNER: It's a simulated representation of a body part.

25 MR. THISSELL: It could be. It could be photographs. It could be,
26 you know, enhanced photographic images.

1 JUDGE LORIN: What exactly are you pointing to in this claim that,
2 that reflects a transformation? Are you, are you saying facilitating display of
3 a simulated facial image?

4 MR. THISSELL: Well, the facilitating display step specifies that the
5 displayed facial portion has a simulation of beauty product, and then it
6 corresponds with the displayed facial portion in the selected template. So
7 there's, there's the three steps. There's facilitating display of the templates,
8 enabling the selection and then facilitating display on this central -- this
9 main image of, of the portion of the template, well, of the portion of the face
10 that corresponds with what's in the template. So you're constructing this,
11 this main image, image 700, the main image that's shown in the, in the
12 figure. You're constructing it by making the selection.

13 So which means you've got a simulated facial image. That's in the
14 first line of that, of that clause. That's the main picture. And then you've got
15 the simulated facial portion in the template, and you're adding to the
16 simulated facial image the simulated facial portion from the template. Your
17 claim clearly sets forth that part of that image is constructed from the
18 templates.

19 JUDGE FETTING: Where does it say it's constructed from the
20 template?

21 MR. THISSELL: Well, it, it says that -- the first line, facilitating
22 display on a display device of a simulated facial image including at least one
23 displayed facial portion, have a simulation of use of beauty product. The
24 next part says wherein the displayed facial portion having simulation of a
25 simulated facial image corresponds to a facial portion of the at least one
26 selected template.

1 JUDGE FETTING: All that says is it has a correspondence. That
2 doesn't say anything changed. I mean that, that would read on just selecting
3 an image that only has that correspondence within it. That just reads on
4 selecting an image that has the desired attributes. I don't see anything in
5 here that actually says anything has changed.

6 MR. THISSELL: Well, to look at it from that perspective, it's still
7 creating -- I see what you're getting at where you say that, that you're not --
8 you haven't changed the, the image. I think what you're saying is that the
9 image wouldn't change until you selected a different template, and then
10 presumably it would change.

11 JUDGE FETTING: And then all you've done is replace one image
12 with another image. You haven't necessarily changed an image. You've
13 just --

14 MR. THISSELL: Well, you've changed the data that, that makes up
15 that image.

16 JUDGE FETTING: You've changed what's on the display. I mean
17 you've brought up a different document. You've brought up a different
18 image.

19 MR. THISSELL: Well, what I was going to say was that in order to
20 make the image in the first place, you, you select the template, so the
21 creation of the image in the first place, the transformation of data into an
22 image to display it.

23 JUDGE FETTING: Well, that occurred before you even started this
24 process here. Because this, this -- you're simply displaying that which has
25 already been created.

1 MR. THISSELL: But there is nothing in the claim that says that it's
2 already been created.

3 JUDGE FETTING: There's nothing in that says that it hasn't either.
4 There's nothing in the claim that says that you're changing anything. You
5 seem to be postulating that, that one way to do this is you can change stuff.
6 Well, yes, and another way to do it is just select amongst images that have
7 already been created. There's nothing in here that I can see that says that
8 you're changing anything.

9 MR. THISSELL: But there isn't a selection of images that have
10 already been created. There's a selection of, of facial portions or
11 templates --

12 JUDGE FETTING: Right.

13 MR. THISSELL: -- that have already been created.

14 JUDGE FETTING: Okay.

15 MR. THISSELL: And then from that there is a simulated facial
16 image, the whole picture that's created from doing that.

17 JUDGE FETTING: It doesn't say created. It just says has -- happens
18 to have certain portions that correspond in some way. It doesn't say
19 anything changed. It doesn't say that anything is being modified. It just says
20 that some portions have some correspondence with other portions, and
21 doesn't say when that correspondence occurred. May have occurred a year
22 ago. It might be occurring now. But I don't see in this claim where it says
23 when that correspondence is being made for the first time.

24 MR. THISSELL: I think, I think that doesn't give enough weight to
25 the claim interpreted as a whole. If you've got the three steps that are clearly
26 laid out, facilitating display of a plurality of templates, selection of one of

1 the templates and then displaying a simulated facial image having portions
2 that correspond with the selected template, I mean when you read the claim
3 as a whole that -- to me that lays out a pretty clear construction of, of this
4 final displayed image, and that's where I think, I think this claim needs to be,
5 needs to be read in its entirety, and I think that's part of what happened with
6 the Examiner was the Examiner was picking certain claim limitations and
7 not considering how those claim limitations were then modified and
8 elaborated on later in the claim, and I think, I think that's, that's how this
9 claim has to be interpreted and as any claim should be, but as, as a whole
10 read, read in complete, in complete --

11 JUDGE LORIN: Well, you can see we're struggling with the
12 transformation prong of the Bilsky test as it pertains to this claim, but what
13 about the other prong, that it's tied to a particular machine?

14 MR. THISSELL: Well, I think that there's -- the two aspects of it that
15 tie it to a machine, the first is that the display is facilitated on a display
16 device, both the display of the templates and the display of the simulated
17 facial image. And then furthermore, the templates themselves and the
18 simulated facial image itself is a representation of a physical object. It's a
19 simulation of a physical object. So to that point the, the connection of the
20 claim to a machine, it's got a quite literal connection in terms of the display
21 device and then a more indirect connection in terms of the, the simulation
22 and the representation of a physical object.

23 JUDGE FETTING: Why isn't a large artist's pad on an easel, an easel
24 a display device?

25 MR. THISSELL: Well, again, looking at the claim in its entirety,
26 you're talking about having -- making a selection of the templates and then

1 having a simulated facial image, having portions that correspond with that
2 simulation and I think --

3 JUDGE FETTING: Well, your specification talks about police and,
4 you know, police doing simulations, and isn't that what, what a police artist
5 does, creates simulated faces on paper with, with crayon or ink or whatever?
6 Isn't he creating a simulation?

7 MR. THISSELL: I'm looking at the claim language to consider
8 whether the, the display device should be considered that broadly.

9 JUDGE LORIN: But I thought scope didn't matter.

10 MR. THISSELL: If, if it is -- even if it were, we're talking about 101,
11 that would be a physical device, and perhaps that would, that would further
12 support the connection to a machine or mechanical componentry. You
13 know, whether the display device is, is a computer, a machine of some sort,
14 a screen or an easel, that I think in any case it would be a mechanical
15 component.

16 JUDGE LORIN: Okay, counsel, I think we understand your position
17 on the 101. Would you like to continue on the others?

18 MR. THISSELL: Sure. The, the best analysis I think of the rejection
19 under 102 and 103 but mostly under 102 is in the reply brief, because the
20 Examiner changed his position from the final rejection to the time he
21 actually made the Examiner's answer. So the reply brief is the best example,
22 and looking at figure 3 of the Orpaz reference, what the Examiner tried to
23 say was remember a moment ago I mentioned that the Examiner was
24 looking at certain limitations of the claims without then considering how
25 those limitations were further described in the claim. And what the
26 Examiner tried to say was that in the first clause, facilitating display,

1 Examiner identified the, the phrase that says wherein at least some of the
2 templates are representative of a portion of a face, and the Examiner didn't
3 look at the rest of the claim and just said well, if only some of the templates
4 have to be representative of a portion of the face, then these elements over to
5 the left in the Orpaz reference can qualify as the templates, because those
6 don't have representations of portions of faces, but they, they don't have to.

7 Well, looking at the third clause of the claim, the facilitating display
8 of the simulated facial image, it ties the, the simulated templates to the, the
9 simulated facial image and the, the simulated facial portions, so while the
10 templates in the claim can be both -- feature both facial portions and other
11 portions, whether that's a hand or a wrist or nails or something like that, the
12 claim still requires that the simulated facial image be displayed and that
13 the -- there be a correspondence between what's on that simulated facial
14 image and what's in the templates. So the, the Examiner failed to recognize
15 that the templates are then further discussed in the third clause and that
16 they're tied to the facial image in that respect.

17 And further upon making that conclusion, the Examiner looked at this
18 reference and concluded that the central image of the overall face and the --
19 these icons to the left of the drawing, that any of those could be the
20 templates, but that's not the case either, because the central image isn't
21 something that's selectable. You can't select that as a template, so that can't
22 be a template.

23 So rather than have, as we have in our figure 10C, simulated facial
24 portions like eyes, lips, cheek or any other facial portions as our selected
25 template, the Orpaz reference has these icons over to the left, and when you
26 select, for example, it shows you select the, the lips icon, it shows a list of

1 the different type of products that could be used for the lips, lipstick, lip
2 gloss, pencil, etc. And then upon choosing, for example, lipstick, down at
3 the bottom it shows an actual lipstick with, with various colors, and you
4 choose from the colors. And when you do that, then the facial image on the
5 screen changes to have the color that you've selected of the lips. But the lips
6 don't correspond with anything that you've selected in terms of the facial
7 portion that's on, on the, the central picture in Orpaz does not correspond
8 with any facial portion of the templates, because the, the templates don't
9 have facial portions showing. They're just icons lists and pictures of lipstick.

10 JUDGE FETTING: Well, it does have the one central image, and
11 that's certainly a facial portion. And now you -- in, in this reference Orpaz,
12 you select different lipsticks or different rouges or what have you. And
13 when you select them, there is -- that is tied to a specific portion of the
14 central facial image. That changes when you select it. So why isn't the
15 selection of the lipstick a selection of a template?

16 MR. THISSELL: Because the lipstick isn't a template as it's defined
17 in our claims. The templates include representations of facial portions.

18 JUDGE FETTING: Wherein at least some of the templates are
19 representative of a portion of a face.

20 MR. THISSELL: But the central -- the, the simulated facial image,
21 the overall image, the full facial image includes a facial portion that's -- that
22 corresponds with a facial portion of at least one selected template. So that
23 specifies that the selected template needs to have been one that includes a
24 representation of a facial portion, and none of these selectable items in
25 Orpaz includes a facial portion that corresponds with any facial portions on
26 the image.

1 JUDGE FETTING: So the, so the only distinction is, is -- that you're
2 referring to is the actual content of the image in each of the templates. In
3 Orpaz clearly you select something, and when you select that something, it,
4 it does create a simulation of a displayed facial portion that corresponds to a
5 simulation of some portion of a face with that cosmetic applied to it. You
6 select lipstick and it, and it creates a simulation of the lips without lipstick
7 applied to it.

8 MR. THISSELL: Um-hum.

9 JUDGE FETTING: It seems like the only thing that you're saying is
10 that the image that you click on is an image of lipstick rather than an image
11 of lips. I'm --

12 MR. THISSELL: The other way around. The --

13 JUDGE FETTING: Is that, is that a patentable distinction?

14 MR. THISSELL: Well, this is -- the idea behind it is to provide the
15 enhanced detail of these templates that are -- that show what the eye shadow
16 is going to look on the eyes before you select it. With the, with the Orpaz
17 reference --

18 JUDGE FETTING: I don't see that in the claim. I'm sorry.

19 MR. THISSELL: Well, in the claim we have the, the recitation that
20 the facial portion that's in the, the displayed facial image, the simulated
21 facial image, corresponds with the facial portion in the selected template. So
22 it's tying the two together so that what you see in the templates is by and
23 large what you see when, when it gets applied to the simulated facial image.
24 So you don't have to go through the exercise of clicking on seven different
25 lipsticks to figure out which color looks best to achieve the look that you're
26 going for. In this situation, you could look at a number of templates, and it

1 will have a, you know, a smaller representation of or a representation of a
2 smaller portion of the face just including that, that area to which the beauty
3 product has been applied, the lips or the, the cheeks or the eyes and, and
4 that's the, the difference between the two applications, between the two
5 claims in the reference. The reference just has the, the listing or the, the
6 series of selectable lipsticks at the bottom, and it changes the, the face. But
7 you don't know what it's going to look like until you select on it, until you
8 choose something that's selectable.

9 JUDGE FETTING: Okay. Now I know we're running low on time. I
10 just want to -- I, I notice that the Examiner in, in the final rejection has
11 slightly different take on what the templates were. He, he was of the opinion
12 that the alpha channels in the central facial image were the individual
13 templates, and I guess I'm wondering why that would not have read on the
14 claim given that the alpha channels, although they are buried within the
15 image, they certainly are masks that are in addition to the image. That is to
16 say you have, you have the overall images you see in figure 3, and then you
17 have an alpha channel for the cheeks. You have an alpha channel for the
18 eyes. You have an alpha channel for the lips, each of which is separate
19 within the data file and each of which can be selected by selecting the --
20 admittedly by selecting the, the cosmetic. You don't go and select the alpha
21 channel directly. It's an indirect selection.

22 MR. THISSELL: Um-hum.

23 JUDGE FETTING: But of course, you've defined selection as
24 including indirect selection in your specification. So, so in terms of
25 facilitating display of a plurality of templates, given that each of those alpha
26 channels are visible, certainly very visible once you apply the makeup on the

1 image, and when you apply the makeup, such a simulation is displayed that
2 corresponds to a simulation of, of that particular alpha channel with that
3 particular makeup. I'm not sure why that did not read on claim 1.

4 MR. THISSELL: I think you correctly noted that the alpha channels
5 are not something that are displayed in and of themselves, and that was the
6 mistake the Examiner had made initially was thinking that these were what
7 you've seen, figures 16, 17, that these are -- the Examiner thought that these
8 were something that was shown on the screen. You could select them and
9 that they would show up on the, the image, but that's not the case. These
10 are --

11 JUDGE FETTING: Well, they do show up on the image, correct?
12 And they're masks on various parts of the image, on the cheeks, the lips --

13 MR. THISSELL: Yes, and, and the --

14 JUDGE FETTING: -- the ears, eyes --

15 MR. THISSELL: -- distinction is that these alpha channels are not
16 templates that are displayed that are selectable. You cannot select an alpha
17 channel --

18 JUDGE FETTING: Why not? You, you select lipstick. If I select
19 lipstick, I've selected the, the alpha channel for lips. If I select eye shadow,
20 I've selected the alpha channel for the eyebrows.

21 MR. THISSELL: But the displayed, the displayed template does not
22 include a representation of a facial portion. The displayed template still has
23 a picture of lipstick. There is, there -- yes, the alpha channel shows up on
24 the, the main image once you've chosen whatever color lipstick it is you
25 want, but there's still no template that includes a displayed facial portion.

1 JUDGE FETTING: Well, they are certainly representative of a
2 portion of a face. I mean they, they certainly --

3 MR. THISSELL: What are, the alpha channels?

4 JUDGE FETTING: -- the ones for lips are representative of the lips.
5 The ones for eyes, eyes are representative of the eyes and, and your first
6 facilitating display says that the templates are representative of a portion of a
7 face. It doesn't say they actually display a portion of a face.

8 MR. THISSELL: But then you still need to look to the third clause in
9 the claim that specifies that what's displayed on the simulated facial image
10 corresponds with the facial portion that's displayed on the selected template.

11 JUDGE FETTING: And?

12 MR. THISSELL: So there is nothing to indicate in Orpaz that the
13 eyes that are up on the top left-hand corner icon correspond with what's
14 showing up on the picture. It's just a picture of an eye. Same thing with the
15 lips and the icon below it.

16 JUDGE FETTING: No, but the alpha channel itself, the mask alpha
17 channel corresponds directly to the eyes. The mask for the eyes corresponds
18 to the eyes. The alpha channel for the nose corresponds to the nose. It
19 represents -- it's representative of the nose.

20 MR. THISSELL: But if the simulation on the -- of the facial portion
21 on the simulated facial image in Orpaz doesn't correspond to the simulated
22 facial portion in, in the -- what the Examiner is calling the templates, the
23 icons to the left.

24 JUDGE FETTING: Well, that's what, that's what the Examiner
25 referred to in the Examiner's answer. In the final rejection, the Examiner
26 referred to the alpha channel as the template, and I'm suggesting that it does

1 correspond to the alpha channel. The simulation actually -- because the
2 simulation is in fact a mixture of the value in the alpha channel and the, and
3 the value on the underlying image.

4 MR. THISSELL: Well, if --

5 JUDGE FETTING: So they have to be looking at the same thing.

6 MR. THISSELL: If you're looking at it -- if you'll be looking at it that
7 strictly, the, the alpha channel isn't displayed as, as a selectable template.
8 The alpha channel only shows up visibly once it's, once it's on the simulated
9 facial image, and so that's why the alpha channel can't, can't be equated with
10 the --

11 JUDGE FETTING: Well, it, it certainly is a display template, because
12 it is, it is extant on the image. I mean the alpha channel for the cheeks is
13 directly over the cheeks, and the alpha channel for the eyes is directly over
14 the eyes and, and the question is is how is it selected. Well, the, the claim
15 doesn't specify how it's selected. In Orpaz, you select an alpha channel by
16 selecting a beauty product. Seems like that's a valid way to select something
17 in claim 1, I mean enabling selection. It doesn't say that you actually point
18 directly to the template. It just says that you select one of the templates.
19 And again, it's -- you said it can be an indirect, you know, selection can be
20 indirect.

21 MR. THISSELL: But the templates still need to be displayed.

22 JUDGE FETTING: They're displayed. They're -- you apply rouge,
23 and you'll see that template real fast, I mean because that alpha channel will,
24 will absorb the color of that rouge.

25 MR. THISSELL: Well, then that template is not -- hasn't been
26 selected. That template just showed up. You selected a choice, a list -- from

1 a list of lipstick or from a series of pictures of lipstick, and then the alpha
2 channel showed up. The alpha channel was not the template itself. The
3 alpha channel is the data that shows up on the final image. It's still not
4 something that's being selected. So looking at the first two clauses of our
5 claim, facilitating display of templates that are representative of a portion of
6 a face, and then enabling selection of at least one of the displayed templates.

7 JUDGE FETTING: Right.

8 MR. THISSELL: Just reading those two together, the alpha channels
9 don't read on that, or those don't read on the alpha channels.

10 JUDGE FETTING: If you select lipstick, lipstick is tied to the alpha
11 channel for lips. Orpaz is pretty clear on that, because there's a one to --
12 there's a many to one correspondence. Each cosmetic is tied to one alpha
13 channel. Orpaz says that. Otherwise that wouldn't know how to, how to
14 apply it. So when you select lipstick, you are indirectly selecting lips. So
15 you are indirectly selecting the alpha channel of lips which is displayed, and
16 it's easy to see that it's displayed, because as soon as you select the lipstick,
17 the color of that particular portion of the face of that alpha channel changes
18 to match the color of a lipstick that you have selected. Now it's an indirect
19 selection, but again, you've defined selection to be -- to allow indirection --
20 indirect types.

21 MR. THISSELL: Let me see if I understand your, your point. Is it
22 that these -- the two -- are you saying that the first two clauses in our claim
23 don't necessarily have to occur in that order? You're saying that the
24 selection of the templates could occur before the recited facilitating of a
25 plurality of templates?

1 JUDGE FETTING: Not necessarily. The alpha channel is, is always
2 visible. It's just a question of whether it's transparent or not. It's, it's there.
3 It might be transparent, but it's certainly displayed.

4 MR. THISSELL: My understanding is that the alpha channel is a, is a
5 series of data that, that --

6 JUDGE FETTING: Well, everything in the image is data.

7 MR. THISSELL: -- corresponds to the -- what gets shown on the
8 image.

9 JUDGE FETTING: Exactly. It's a portion of the -- it's a copy of a
10 portion of the image.

11 MR. THISSELL: So how does that equate to a displayed selectable
12 template?

13 JUDGE FETTING: Well, it corresponds to displayed template,
14 because it is displayed. It's on the display, and it's representative. You
15 define a template as refers to a representation that is reflective of subject
16 matter that may be incorporated. So certainly the alpha channel for lips is a
17 representation that is reflective of the lips. So the alpha channel certainly
18 meets your definition of a template, and it's certainly displayed, because it is
19 in fact a mask that is overlaid on top of the image. Now it may be
20 transparent initially, but it's certainly still there.

21 MR. THISSELL: So here's, here -- this is what I think the distinction
22 is. We're facilitating display of a plurality of templates, and at no time is a
23 plurality of selectable alpha channels shown.

24 JUDGE FETTING: Why not? I mean there's, there's an alpha
25 channel for each of the eyes. There's an alpha channel for the eyebrows.
26 There's an alpha channel for the lips. There's an alpha channel for the

1 circumference around the lips, for the lip liner. I mean there, there's -- there
2 are several alpha channels on display simultaneously.

3 MR. THISSELL: Well, I think, I think the distinction is that the alpha
4 channels are not displayed in a way that they can be selected initially.
5 They're, they're still not a display of a facial image that -- a portion of a face
6 that's selected and reading -- again, reading the, the clauses of the claims
7 together, the, the alpha channels -- they can't be applied to multiple features
8 in the claims. The, the alpha channels are either the simulated facial image
9 or they're the template. And essentially what you're saying is that they're
10 both, because if you look in the third clause of the claim, it says we've got a
11 simulated facial portion on the simulated facial image, and that corresponds
12 to the simulated facial portion in the template.

13 JUDGE FETTING: Right.

14 MR. THISSELL: And you're, you're essentially saying that the alpha
15 channels are both.

16 JUDGE FETTING: No, no, I'm saying the alpha channel is a separate
17 mask that is laid on top of the facial image.

18 I'm aware of the time. I'm sorry. I know I've taken over time.

19 But I'm not saying they're both. I'm saying, I'm saying that they're
20 two -- and in fact, that's, that's what Orpaz says too. It's additional data. It's
21 within the same file, but it's additional data. It's not the same as the facial
22 image itself.

23 MR. THISSELL: But that's, that's the only place that, that it's
24 displayed. It's not displayed as a template. It's displayed as part of the facial
25 image.

26 JUDGE FETTING: Well, it's displayed on top of the facial image.

1 MR. THISSELL: But that -- I mean that's the image. You're looking
2 at the image. It -- when you're looking at the image, you don't see oh, there's
3 the image, and there's the alpha channel. You see the image with the alpha
4 channel that's modified it.

5 JUDGE FETTING: Okay.

6 MR. THISSELL: That's where we stand on that claim.

7 JUDGE LORIN: All right, thank you, counsel. Do you have any
8 more comments?

9 MR. THISSELL: The only further comment I would have would be
10 with regard to the, the 103 rejection. I think our remarks on that are fairly
11 clear, but I think it may be worth noting what we see that the distinction is
12 and that's that the, the -- I think it's Lambertsen reference, it refers to
13 modifying these outlines around what's shown in the image, and this is with
14 respect to claim 12 which, which specifies that the method of claim 1 further
15 comprising, comprising enabling selection of at least one of a size and shape
16 for at least one of head, eyes, nose, lips, ears and eyebrows, and what
17 Lambertsen, what Lambertsen does is it includes -- the best example is
18 figure 4 in Lambertsen. It has areas that are -- that have an outline within
19 which you can -- it even describes it in the specification that you select and
20 fill with a particular color, and you can change the shape of these outlines
21 but --

22 JUDGE FETTING: But isn't it true that in paragraph 10 it uses the
23 exact phrase that's in your claim where it says the user defines the size and
24 shape of the specific feature? I mean so he's using, he's using your phrase.

25 MR. THISSELL: Again though, the, the difference is in the
26 templates. In claim 12, it says enabling selection of the size and shape of the

1 head, nose, lips, ears and eyebrows, and this is not selecting the size of the
2 eyebrows. It's selecting the area to which the, the cosmetic is being applied.

3 JUDGE FETTING: I don't see the word "size" in claim 12.

4 MR. THISSELL: One of a size and shape.

5 JUDGE FETTING: Oh, I'm sorry, size and shape, but again -- I'm
6 sorry, but, but that, that word, the user defines the size and shape of a
7 specific feature in, in paragraph 10. So he is defining the size and shape.

8 MR. THISSELL: But these are shapes of the cosmetic to which is --
9 that's being applied. It's, it's outlining the area where they want it to be
10 applied. I don't think they're saying that it's changing the image. Is it
11 changing the image of the nose or the outline of the face?

12 JUDGE FETTING: It just says that claim 12 says selection of at least
13 one of a size and shape.

14 MR. THISSELL: But again --

15 JUDGE FETTING: Paragraph 10 says the user defines the size and
16 shape of a specific feature for which a treatment of manipulation is desired.

17 MR. THISSELL: Well, I don't want to take up your time --

18 JUDGE FETTING: Okay.

19 MR. THISSELL: -- looking through paragraphs 10 and 11, but in our
20 analysis the distinction was the fact that it was the outlines of areas of the
21 face and not shapes of the facial features.

22 JUDGE LORIN: Any more questions?

23 JUDGE HORNER: No.

24 JUDGE LORIN: No more questions?

25 JUDGE FETTING: No.

1 JUDGE LORIN: Thank you, counsel. We'll take your comments
2 under advisement.

3 MR. THISSELL: Thank you.

4 (Whereupon, the hearing concluded on February 10, 2009.)